

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

---

In re Patent Application of: Heinz Kohler et al.

Application No.: 10/652,864

Confirmation No.: 1487

Filed: August 29, 2003

Art Unit: 1643

For: THERAPEUTIC APPLICATIONS OF  
NONCOVALENT DIMERIZING ANTIBODIES

---

Examiner: D. J. Blanchard

**RESPONSE TO NON-FINAL OFFICE ACTION**

Mail Stop AMENDMENTS  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In response to the Office Action dated September 25, 2008, the Examiner's attention is directed to the following remarks.

Claims 7-10 are pending in the application. All of these claims currently stand rejected. Although no claim amendments are being submitted herein, the claims in their current state are attached for the convenience of the Examiner.

**Rejection of Claim 7 under 35 U.S.C. §103(a)**

Claim 7 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Nakamura et al. (Cancer Research, 54(6):1511-1516, 1994), in view of Kohler [a] (U.S. Patent No. 6,238,667) and Kang et al. (Science, 240:1034-1036, 1988).

As noted by the Examiner, the rejection may be overcome by showing under 37 CFR §1.132 that any invention disclosed but not claimed in the Kohler [a] reference, U.S. Patent No. 6,238,667 was derived from the inventor of this application and is this not an invention "by another." Applicant submits herewith a Declaration under 37 CFR §1.132 by the inventor of the

instant application stating that any work relating to the present application which is disclosed in U.S. Patent No. 6,238,667 was derived from the inventor of this application.

Applicant therefore submits that no *prima facie* case is established and respectfully requests withdrawal of the rejection and allowance of the claim.

#### **Rejection of Claims 8-10 under 35 U.S.C. §103(a)**

Claims 8-10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Nakamura et al. (Cancer Research, 54(6):1511-1516, 1994), in view of Kohler [b] (U.S. 2003/0103984) and Kang et al. (Science, 240:1034-1036, 1988) and Zhao et al. (J. Immunol. Methods, 254(1-2):137-145, 2001) and Singh et al. (U.S. Patent No. 7,041,459).

As noted by the Examiner, the rejection may be overcome by showing under 37 CFR §1.132 that any invention disclosed but not claimed in the Kohler [b] reference, U.S. 2003/0103984 was derived from the inventor of this application and is this not an invention "by another." Applicant submits herewith a Declaration under 37 CFR §1.132 by the inventor of the instant application stating that any work relating to the present application which is disclosed in U.S. 2003/0103984 derived from the inventor of this application.

Applicant therefore submits that no *prima facie* case is established and respectfully requests withdrawal of the rejection and allowance of the claims.

#### **Double Patenting Rejection of Claims 7-10**

Claims 7-10 stand rejected on the ground of nonstatutory obviousness-type double patenting over claims 1-3, 7, 10-11 and 17 of U.S. Patent No. 6,238,667 in view of Nakamura et al. (Cancer Research, 54(6):1511-1516, 1994), and Kohler [b] (U.S. 2003/0103984) and Kang et al. (Science, 240:1034-1036, 1988) and Zhao et al. (J. Immunol. Methods, 254(1-2):137-145, 2001) and Singh et al. (U.S. Patent No. 7,041,459).

Applicant notes the double patenting rejection and is willing to submit a terminal disclaimer, if appropriate, in the case that conflicting claims are allowed in the present case.

It is submitted that the present claims are in condition for allowance, and allowance of the same is respectfully requested. Applicant's below-signed representative may be contacted to discuss this application at the telephone and/or facsimile numbers provided below.

Dated: Dec. 16, 2008

Respectfully submitted,

By 

Julie K. Staple

Registration No.: 50,434

GIFFORD, KRASS, SPRINKLE, ANDERSON  
& CITKOWSKI, P.C.

2701 Troy Center Drive, Suite 330

Post Office Box 7021

Troy, Michigan 48007-7021

(734) 913-9300 (734) 913-6007 (Fax)